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OFFICE OF PETITIONS

In re Application of	:	
Restle et al.	:	DECISION ON APPLICATION
Application No. 09/360,521	:	FOR
Filed: July 23, 1999	:	PATENT TERM ADJUSTMENT
Atty Docket No. 05725.0446-0	:	

This is in response to the "NOTICE OF POSSIBLE PTO ERROR IN THE DETERMINATION OF PATENT TERM ADJUSTMENT AND REQUEST FOR REVIEW OF CALCULATION," filed December 3, 2008. This paper is properly treated pursuant to 37 CFR 1.705(b). Applicants request that the Office correct the patent term adjustment at the time of the mailing of the notice of allowance from five hundred fifty (550) days to four hundred twelve (412) days.

The application for patent term adjustment is GRANTED to the extent indicated herein.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is **five hundred sixty-eight (568)** days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On November 6, 2008, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is 550 days. Applicants disclose that a period of reduction pursuant to 37 CFR 1.704(c)(7) should have been entered for the filing of an appeal brief with an omission on May 24, 2006. Further, applicants maintain that a period of adjustment of 18 days should be entered for the Office taking in

excess of four months to issue a Notice of Allowance in response to a favorable decision by the Board of Patent Appeals and Interferences.

37 CFR 1.702(a)(3) provides that the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to:

Act on an application not later than four months after the date of a decision by the Board of Patent Appeals and Interferences under 35 U.S.C. 134 or 135 or a decision by a Federal court under 35 U.S.C. 141, 145, or 146 where at least one allowable claim remains in the application;

37 CFR 1.703(a)(5) provides that:

The number of days, if any, in the period beginning on the day after the date that is four months after the date of a final decision by the Board of Patent Appeals and Interferences or by a Federal court in an appeal under 35 U.S.C. 141 or a civil action under 35 U.S.C. 145 or 146 where at least one allowable claim remains in the application and ending on the date of mailing of either an action under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151, whichever occurs first;

As stated in the Final Rule¹ and in pertinent part in MPEP 2731,

For a Board of Patent Appeals and Interferences decision to be a "decision by the Board of Patent Appeals and Interferences under [35 U.S.C.] 134" within the meaning of 35 U.S.C. 154(b)(1)(A)(iii) (and 1.703(a)(5)), the decision must sustain or reverse the rejection(s) of the claim(s) on appeal. For a Board of Patent Appeals and Interferences decision to be a "decision by the Board of Patent Appeals and Interferences under [35 U.S.C.] 135" within the meaning of 35 U.S.C. 154(b)(1)(A)(iii) (and 1.703(a)(5)), the decision must include a decision on the patentability of the claims or priority of invention. A remand or other administrative order by the Board of Patent Appeals and

¹ See *Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term*; Final Rule, 65 Fed. Reg. 54366 (September 18, 2000).

Interferences (even if by a merits panel) is not a "decision" within the meaning of 35 U.S.C. 154(b)(1)(A)(iii) (and 1.703(a)(5)).

In this instance, such a favorable decision by the Board was mailed on June 19, 2008. The Office did not mail an Office action, a notice of allowance, in response until November 6, 2008, four months and 18 days later. Pursuant to 37 CFR 1.703(a)(5), a period of adjustment of 18 days should have been entered. The period of adjustment of 18 days is being entered.

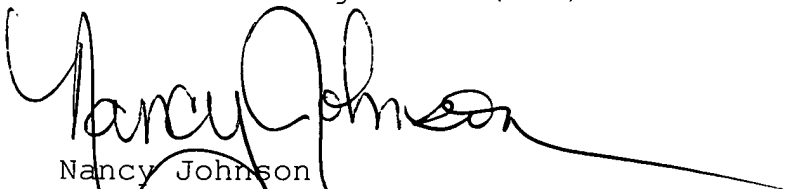
However, entry of a period of reduction, pursuant to 37 CFR 1.704(c)(7), is not warranted. An appeal brief is not a reply within the meaning of 37 CFR 1.704(c)(7). Accordingly, entry of a period of reduction for filing a defective appeal brief is not warranted.

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is five hundred sixty-eight (568) days.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application is being forwarded to the Office of Data Management for issuance of the patent. Any further period of adjustment accrued pursuant to 37 CFR 1.702(a)(4) and 1.702(b) will be reflected in the patent term adjustment shown on the issue notification letter mailed approximately three weeks prior to the issuance of the patent.

Telephone inquiries specific to this decision should be directed to the undersigned at (571) 272-3219.


Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of Revised PALM Screen

PTA Calculations for Application: 09/360521

Application Filing Date:	07/23/1999	PTO Delay (PTO):	878
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	328
Post-Issue Petitions:	0	Total PTA (days):	568
PTO Delay Adjustment:	18		

File Contents History

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122	11/15/2007	DOCKETING NOTICE MAILED TO APPELLANT			
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104	09/20/2006	DATE FORWARDED TO EXAMINER			
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103	09/11/2006	APPEAL BRIEF FILED			
102	08/10/2006	NOTICE -- DEFECTIVE APPEAL BRIEF			
101	05/31/2006	DATE FORWARDED TO EXAMINER			
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81	11/08/2004	CASE DOCKETED TO EXAMINER IN GAU			
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67	09/12/2003	REQUEST FOR CONTINUED EXAMINATION (RCE)			
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35	01/31/2002	CASE DOCKETED TO EXAMINER IN GAU			
34	01/22/2002	MAIL ADVISORY ACTION (PTOL - 303)			
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20	03/26/2001	CONTINUING PROSECUTION APPLICATION - CONTINUATION (ACPA)			
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